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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,042	04/08/2004	Sylvain Baratin	11016-0027	7324

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EXAMINER

STRIMBU, GREGORY J

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/820,042	BARATIN ET AL.	
	Examiner	Art Unit	
	Gregory J. Strimbu	3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/18/04</u> . | 6) <input type="checkbox"/> Other: ____. |

Drawings

Figures 1, 2 and 5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "5" has been used to designate both a tubular portion in the prior art and a tubular portion in the present invention, additionally, reference character "3" has been used to designate both a fixing portion of the prior art and the present invention. Since the tubular portion and the fixing portion are different for the prior art and the present invention they require different reference characters. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required

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corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to because the applicant has not used the proper cross sectional shading when showing the invention in cross section. For example, figure 3 improperly shows the adhesive 7 with a metal cross sectional shading. Additionally, figure 5 does not agree with figure 1 since figure 1 shows the tubular portion comprising different materials while figure 5 shows the tubular portion comprising the same material throughout. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because the legal phraseology "said" on line 9 should be avoided. On lines 3-4, "one corner of small radius of curvature" is confusing because it is grammatically awkward and confusing. On lines 9-13, "its right section is subject to deformation that occupies . . . in the free state" is confusing because it is unclear what the applicant is attempting to set forth. What is a "right section"? What element of the invention or process deforms the gasket? Correction is required. See MPEP § 608.01(b).

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title of the invention is confusing since it is unclear whether the door or the gasket presents the corner.

The disclosure is objected to because the description of figures 8 and 9 on page 4 is inadequate since each figure is not described separately. Recitations such as "h" on line 20 of page 7 should be changed to --h-- to avoid confusion.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The specification lacks antecedent basis for the claim terminology in claim 13.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "in particular on a motor vehicle door" on line 2 of claim 1 render the claims indefinite because the applicant has used a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim). Therefore, the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present

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instance, claim 1 recites the broad recitation a support, and the claim also recites a motor vehicle door which is the narrower statement of the range/limitation. Recitations such as "one corner of small radius of curvature" on lines 3-4 of claim 1 render the claims indefinite because they are grammatically awkward and confusing. Recitations such as "fixed to its support" on line 5 of claim 1 render the claims indefinite because it is unclear if the applicant is claiming the subcombination of a gasket or the combination of a gasket and a support. The preamble of claim 1 implies the subcombination while the positive recitation of the support implies the combination. Recitations such as "its right section" on lines 9-10 of claim 1 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Is the applicant referring to a cross section? Recitations such as "deformation" on line 10 of claim 1 render the claims indefinite because it is unclear what element or process is deforming the gasket. Recitations such as "that occupies" on line 10 of claim 1 render the claims indefinite because it is unclear to what element of the invention the applicant is referring. Recitations such as "an angle" on lines 1-2 of claim 3 render the claims indefinite because it is unclear if the applicant is referring to the angle set forth above or is attempting to set forth another angle in addition to the one set forth above. Recitations such as "the inner and outer . . . the arch" on lines 1-2 of claim 4, "the arch" on line 2 of claim 6, and "said zone" on line 4 of claim 6 render the claims indefinite because they lack antecedent basis. Recitations such as "a loss of gasket height is . . . to 80°" on lines 1-6 of claim 5 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Is the applicant referring to a depression in the gasket? Is the

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applicant referring to state when the gasket is mounted to its support? Recitations such as "or" on line 3 of claim 8 render the claims indefinite because it is unclear which one of the two non-equivalent alternatives the applicant is attempting to positively set forth. Pronouns such as "it" on line 4 of claim 8 should be replaced with the element of the invention to which the pronoun is referring. Recitations such as "one hinge-forming line of weakness" on lines 2-3 of claim 10 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Recitations such as "treatment operation" on line 3 of claim 12 render the claims indefinite because it is unclear what comprises a treatment operation.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2 and 4-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4-12 of copending Application No. 10/820,041. Although the conflicting claims are not identical, they are not patentably distinct from each other because the recitation "for mounting on a support that is to receive it, in particular on a motor vehicle door" in 10/820,042 is equivalent to the recitation "for mounting around a motor vehicle door" in 10/820,041, additionally, the recitation "that occupies an area that lies substantially within the area occupied by the right section of the gasket when in the free state" of 10/820,042 is equivalent to "causing it to project outwards by a maximum of about 2 mm . . . relative to the position of the gasket in the free state" of 10/820,041.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6, 7, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Miura. Miura discloses a sealing gasket 11 for mounting on a support that is to receive it, in particular on a motor vehicle door, the support presenting at least one corner of small radius of curvature as shown in figure 1, the gasket comprising at

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least a flexible or semi-rigid fixing portion 16 fixed to its support by an adhesive 28, and an elastically-deformable tubular portion 12 for providing sealing, wherein once the gasket has been mounted on its support, the elastically-deformable portion is such that in said corner of the support, its right section is subjected to deformation that occupies an area that lies substantially within the area occupied by the right section of the gasket when in the free state, the elastically-deformable portion of the gasket is given a shape extending from its fixing portion that is substantially triangular as shown in figure 4, with two lateral pillars (not numbered, but shown in figure 4) united with each other by an arch (not numbered, but shown in figure 4) and forming between them an angle of about 10° to 30°, said angle being defined using two straight lines passing substantially through the middles of the pillars at 2/5ths and at 4/5ths of the total height of the gasket measured from its fixing portion, the arch has a reduced thickness, the fixing portion 16 includes bearing portions (not numbered, but shown in figure 4) on opposite sides of the adhesive.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miura as applied to claims 1, 2, 6, 7, 11 and 12 above. Miura is silent concerning an angle of 20 degrees.

However, one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill to provide the angle between the two pillars with a value of approximately 20 degrees.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miura as applied to claims 1, 2, 6, 7, 11 and 12 above. Miura is silent concerning the distance between the inner and outer top portions of the arch of the elastically deformable portion.

However, one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill to provide the inner and outer portions of the arch of the elastically deformable portion with a distance greater than 0.7 mm.

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Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miura as applied to claims 1, 2, 6, 7, 11 and 12 above. Miura is silent concerning the loss of gasket height at a corner having a small radius of curvature.

However, one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill to provide the gasket with a loss of height at a corner having a small radius of curvature no greater than 2.5mm.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miura as applied to claims 1, 2, 6, 7, 11 and 12 above, and further in view of Weimar. Weimar discloses a reinforcement 20 in a fixing portion 4 of a gasket.

It would have been obvious to one of ordinary skill in the art to provide Miura with a reinforcement, as taught by Weimar, to increase the strength of the fixing portion.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miura as applied to claims 1, 2, 6, 7, 11 and 12 above, and further in view of Shields. Shields discloses a gasket 10 including a means 31 for weakening the compressibility forces of the gasket.

It would have been obvious to one of ordinary skill in the art to provide Miura with a weakening means, as taught by Shields, to more accurately control the compressibility of the gasket.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miura as applied to claims 1, 2, 6, 7, 11 and 12 above, and further in view of Hess et al. Hess et al. discloses the use of a spool 20 for supplying a gasket 10 to an assembly line.

It would have been obvious to one of ordinary skill in the art to provide the gasket of Miura to an assembly line on a spool, as taught by Hess et al., to save space along the assembly line.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hyer, Kawai et al., Mine et al., Kubo et al., and Kogiso et al. are cited for disclosing a gasket having a small radius of curvature. Teramoto et al. and Ugawa are cited for disclosing a gasket having lateral pillars having an angle between them of about 10 to 30 degrees.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 571-272-6836. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a long horizontal flourish extending to the right.

Gregory J. Strimbu
Primary Examiner
Art Unit 3634
August 18, 2006